

REMARKS

At the outset, Applicant thanks the Examiner for the thorough review and consideration of the pending application. The Advisory Action dated December 8, 2004 has been received and its contents carefully reviewed.

In the final Office Action, the Examiner rejected claims 1, 10, 11, and 20, under 35 U.S.C. § 103(a) as being unpatentable over Wessells et al. (U.S. Patent No. 3,661,660) in view of Barbee et al. (U.S. Patent No. 5,456,788). Further, in the Advisory Action, the Examiner asserted that one of ordinary skill in the art would understand that the “computer monitor (indicator),” to which control means 34 is connected, “is capable of displaying graphical information such as a temperature.” Applicant respectfully disagrees and requests and reconsideration of the present rejection.

The mere possibility that indicators “capable of displaying graphical information such as a temperature” may be within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness. (See M.P.E.P. § 2143.01). Rather, a *prima facie* case of obviousness is established only when there is some objective reason to combine or modify the teachings of the references in a manner that arrives at the invention recited in the claims. Moreover, the teaching or suggestion to make the claimed combination must be found in the prior art and not based on Applicant’s disclosure. (See M.P.E.P. § 2142).

In the present case, the inventive concept of Barbee et al. is entirely silent with respect to displaying an etchant temperature, let alone monitoring etchant temperature. Therefore, Applicant respectfully submits that the indicator of Barbee et al. is, in fact, incapable of displaying an etchant temperature. Further, the mere possibility that an indicator, separate from Barbee et al., may be capable of displaying an etchant temperature is insufficient to establish a *prima facie* case of obviousness absent some objective reason. Because neither Barbee et al. nor Wessells et al. (U.S. Patent No. 3,661,660) teach or suggest this feature of the inventions recited in at least claims 1 and 11, and because no objective reason has been given to support the combination of references against the present claims, Applicant respectfully submits that the rationale in combining Wessells et al. and Barbee et al. is solely and impermissibly based

upon Applicants disclosure via hindsight reasoning. For at least this reason, Applicant respectfully requests withdrawal of the present rejection under 35 U.S.C. § 103(a).

In the final Office Action, the Examiner rejected claims 2-4, 6, 7, and 14-17, under 35 U.S.C. § 103(a) as being unpatentable over Wessells et al. in view of Barbee et al. and further in view of Schnegg et al. This rejection is respectfully traversed and reconsideration is respectfully requested.

Claims 2-4, 6, 7, and 14-17 variously depend from claims 1 and 11, which as discussed above, are patentable over Wessells et al. in view of Barbee et al. Schnegg et al. is asserted by the Examiner as disclosing features recited by dependent claims 2-4, 6, 7, and 14-17. Without reaching the merits of this assertion, Applicants respectfully submit that Schnegg et al. fails to cure the above-cited deficiencies of Wessells et al. in view of Barbee et al. as applied to independent claims 1 and 11 above. Therefore, Applicants respectfully submit that claims 2-4, 6, 7, and 14-17, which variously depend from claims 1 and 11, are patentable over Wessells et al. in view of Barbee et al. and further in view of Schnegg et al.

In the final Office Action, the Examiner rejected claims 5, 12, 13, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Wessells et al. in view of Barbee et al. and further in view of Kanda. This rejection is respectfully traversed and reconsideration is respectfully requested.

Claims 5, 12, 13, and 21 variously depend from claims 1 and 11, which as discussed above, are patentable over Wessells et al. in view of Barbee et al. Kanda is asserted by the Examiner as disclosing features recited by dependent claims 5, 12, 13, and 21. Without reaching the merits of this assertion, Applicants respectfully submit that Kanda fails to cure the above-cited deficiencies of Wessells et al. in view of Barbee et al. as applied to independent claims 1 and 11 above. Therefore, Applicants respectfully submit that claims 5, 12, 13, and 21, which variously depend from claims 1 and 11, are patentable over Wessells et al. in view of Barbee et al. and further in view of Kanda.

Applicant believes the foregoing amendments place the application in condition for allowance and early, favorable action is respectfully solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at (202) 496-7500 to discuss the steps necessary for placing the application in condition for allowance. All correspondence should continue to be sent to the below-listed address.

If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time, or any other fees required to complete the filing of this response, may be charged to Deposit Account No. 50-0911. Please credit any overpayment to deposit Account No. 50-0911. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

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